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IN THE U.S. PATENT AND TRADEMARK OFFICE

APPLICANT: J. G. BEDNORZ ET AL

DATE: DECEMBER 29, 1987

SERIAL NO.: 06/053,307

GROUP ART UNIT: 115

FILING DATE: 05/22/87

EXAMINER: DENNIS ALBRECHT

FOR: NEW SUPERCONDUCTIVE COMPOUNDS HAVING HIGH TRANSITION TEMPERATURE,  
AND METHODS FOR THEIR USE AND PREPARATION

TO: The Commissioner of Patents and  
Trademarks  
Washington, D. C. 20231

PETITION FOR SUSPENSION OF ACTION UNDER 37 CFR 1.103

Applicants respectfully request the Commissioner of Patents and Trademarks to suspend action by the Patent Office on the subject application until March 7, 1988. The fee (\$72.00) for this petition may be charged to Deposit Account No. 09-0468.

In summary, the reason for this request is that the undersigned requires this period of time in order to provide information previously requested by the Examiner as a result of his preliminary review of this application. The information to be provided relates to acts of invention in the United States, where the conception and reduction of practice are based on an idea first conceived and reduced to practice in Switzerland. Evidence of conception and reduction to practice in the United States involves detailed interviews with

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at least 12-15 individuals, many of whom are unavailable. In particular, the inventors are the 1987 Nobel Prize winners in Physics, whose residences are in Europe and whose schedules render their availability extremely limited. This information will be provided to the Patent and Trademark Office in order to overcome potential 35 USC 102(a) references, the provision of which will eliminate considerable unnecessary effort on the part of the examiner and which will expedite prosecution. A more detailed basis for the foregoing petition will now be provided.

#### BACKGROUND

1. The invention concerns the breakthrough discovery of K.A. Mueller and J.G. Bednorz relating to high temperature superconductivity. The inventors received the 1987 Nobel Prize in Physics for this accomplishment, which was followed by worldwide acclaim and efforts to further their concept in superconductor technology.
2. Inventors Bednorz and Mueller first published their initial discovery of superconductivity at high temperatures in September, 1986 in Z. Phys. B, 64, page 189. Subsequent to that first publication, the inventors have au-

thored additional publications, as have many researchers in this field.

3. Because a patent application based on the discoveries described in the aforementioned Z. Phys. B reference was not filed prior to that publication, the subject patent application was filed in the United States based on the allowed one year grace period from the date of publication (Sept. 1986) of this first article. Because there have been intervening publications of others subsequent to the initial publication by the inventors but prior to the date of filing of the subject patent application, an office action based on 35 USC 102 can be prepared by the examiner. However, applicants can and will establish completion of their invention in the United States prior to the date of any of these intervening publications, all of which acknowledge the discovery by the present inventors. In order to eliminate undue effort and expenditure of funds, the subject petition is being filed.

4. Applicants can and will show acts attributable to them, consistent with the discovery described in the aforementioned publication in Z. Phys. B., were made in this country prior to any publication by others who began working in high  $T_c$  superconductivity after the Sept. 1986

publication of the present inventors. This evidence will include introduction into the United States of samples of superconducting material prepared by the inventors and tested in a manner consistent with the acts first described in the Z. Phys. B. article. This work first occurred in the United States at the Yorktown Heights, N. Y. research laboratory of the present assignee, where work continued on a daily basis to reproduce the acts originally accomplished by the inventors in Switzerland, as well as additional acts evidencing superconductivity in these samples.

5. In order to establish completion of the invention in the United States, it is necessary to interview 12-15 individuals, and to locate large volumes of data contained in various notebooks and laboratory progress logs. Many of the people sought to be interviewed have been unavailable and remain unavailable at this time. In particular, the inventors have a schedule which takes them around the world for speaking engagements and other activities based on their celebrity status. I have been informed that they will not be available for further discussions with me until approximately the first week in February, which makes it difficult to quickly com-

plete, review and have executed the papers necessary to establish the required acts in the United States.

6. Because the prosecution of this application will require the provision of this information and further because this is the basic patent application in this technology, it is believed that suspension of any office action to allow the filing of these papers is in the best interest of the patent office, the public, and the inventors. Every effort is being made to expedite and organize the material which will be presented so as to make it as clear and self-explanatory as possible. It is further believed that prosecution of all other applications in the field of high temperature superconductivity will depend to some degree on the prosecution of the subject application, thereby providing another reason to suspend prosecution until the aforementioned information is filed in the patent office.

The undersigned has conducted preliminary interviews with approximately 8 of the individuals required to be interviewed in order to provide the necessary information, and is diligently attempting to provide interview schedules with the other individuals. The data and the various activities described by each will have to be coordinated together with the

laboratory data, charts, plots, etc. evidencing the large amount of activity that was undertaken in 1986 in the United States by others together with and on behalf of the inventors. For this reason, the present request is made.

Respectfully submitted,

J.G. BEDNORZ ET AL



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